REMARKS

Claim 1 has been amended to include the features of canceled claim 11; and claim 12 has been amended to include the features of canceled claim 15.

A. Claims 1-7 and 10-16 were rejected under 35 U.S.C. §102(e) as being anticipated by McConnell et al. (US 6,970,719). The applicant respectfully traverses this rejection for the following reason(s).

Note that in order for an anticipation rejection to be proper, the anticipating reference must disclose exactly what is claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on "inherency," accordingly, each and every element must be expressly described in McConnell.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991).

Claim 1

Claim 1 is directed towards a system for providing a private mobile communication service, comprising, in part:

a public base transceiver station disposed within a public/private common cell area and providing a public mobile communication service.

The Examiner refers us to McConnell's col. 10, lines 49-54, which state:

> "As shown in FIG. 1, public wireless network 14 includes a mobile switching center (MSC) 16 that is connected to the public switched telephone network (PSTN) 18 and another MSC 17 connected to PSTN 18 via MSC 16. Public wireless network 14 also includes a base station controller (BSC) 20, connected to MSC 16, and base transceiver stations (BTSs) 22, 24, and 26, connected to BSC 20. **Each of BTSs** 22, 24, and 26 is provided with one or more antennas to **define** a wireless coverage area, which is termed **a "cell"**."

There is clearly no mention of *a public/private common cell area* in the cited section of McConnell. Thus McConnell fails to meet the standards of anticipation as set forth in the case law cited above.

The final rejection fails to traverse this holding. As highlighted above, each BTS 22, 24 and 26 define their own cell area, and those areas are public cell areas not *public/private common cell areas* as set forth in claim 1.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Claim 1 also calls for *a first mobile station establishing a radio communication channel with the both the public base transceiver station and the private base transceiver station, when the first mobile station moves from a public-only cell area to said public/private common cell area, said first*

mobile station determining whether an identifier indicating a request for the private mobile communication service is added to a dialed phone number entered by a user, establishing a traffic channel with the private base transceiver station when it is determined that the identifier is added to the dialed phone number, and establishing a traffic channel with the public base transceiver station when it is determined that the identifier is not added to the dialed phone number.

Here it is evident that the Examiner has examined the claim, and in particular, the foregoing feature of claim 1, in bits and pieces, instead as a whole.

The Examiner refers to col. 10, lines 1-3; col. 13, lines 19-20; and col.29, lines 42-43 with respect to one portion of the claimed feature, i.e., *a first mobile station establishing a radio communication channel with the both the public base transceiver station and the private base transceiver station*, ignoring the qualifier *when the first mobile station moves from a public-only cell area to said public/private common cell area* which he later refers to McConnell's col. 16, lines 29-30.

The final rejection refers us to McConnell's col. 4, lines 28-30, however this section of McConnell discusses a prior art system known as ROAMEO and has nothing to do with that part of McConnell's invention used in the §102 rejection. To combine a prior art system with McConnell, the Examiner would have to establish a *prima facie* basis of obviousness under §103.

Additionally, col. 4, lines 28-34 clearly disclose that in the ROAMEO system, if a user originates a call in the public wireless network and then moves into the building served by the ROAMEO system during the course of the call, **the call will continue using the public wireless network** (provided the signal from the public wireless network is able to penetrate into the building).

Clearly there is no disclosure in col. 4, lines 28-30 (cited in the final rejection, page 2) that

a first mobile station establishing a radio communication channel with the ***both*** *the public base transceiver station* ***and*** *the private base transceiver station, when the first mobile station moves from a public-only cell area to said public/private common cell area.*

None of the other sections of McConnell cited by the Examiner discuss establishing a radio communication channel with both the public base transceiver station and the private base transceiver station, when the first mobile station moves from a public-only cell area to said public/private common cell area.

As a whole, the claim calls for, *a first mobile station establishing a radio communication channel with the both the public base transceiver station and the private base transceiver station, when the first mobile station moves from a public-only cell area to said public/private common cell area.*

That is, when a first mobile station moves from a public-only cell area to a public/private common cell area, the first mobile station establishes a radio communication channel with both the public base transceiver station and the private base transceiver station.

McConnell discusses "soft" handoffs in col. 29, lines 43-51, i.e.:

> "CDMA systems also take advantage of a CDMA mobile station's ability to communicate on more than one channel at a time to perform, to the extent possible, "soft" handoffs. During a "soft" handoff, a mobile station in communication with a first cell begins to communicate with a second cell. The communication with the first cell can be subsequently dropped when the signal level becomes too low. Soft handoffs are particularly desirable as they provide a "make before break" connection that is almost imperceptible to the user."

Such soft handoffs are well known in the art and are performed over "a radio communication channel," which, contrary to the Examiner's understanding of the art, is not the same as a "voice

channel."

The claim goes on to calls for *said first mobile station determining whether an identifier indicating a request for the private mobile communication service is added to a dialed phone number entered by a user.*

Here the Examiner refers us to McConnell's col.27, lines 1-6, and suggests the dialed value *72 corresponds to the claimed "identifier". Col. 27, lines 1-12 state:

> "Feature Code Updates
>
> Many wireless networks enable mobile station users to update some of their available features by dialing a feature code string that typically begins with a "*" digit. As a typical example, a user may be able to dial the digit string "*72" in his mobile station, followed by a 10-digit directory number, to have calls forwarded to that 10-digit directory number. The present invention beneficially allows mobile stations that subscribe to the private network to use such feature code updates, whether the mobile station is operating in the coverage area of the private network or the public network."

Claim 1 goes on to call for *establishing a traffic channel with the private base transceiver station when it is determined that the identifier is added to the dialed phone number, and establishing a traffic channel with the public base transceiver station when it is determined that the identifier is not added to the dialed phone number.*

Here the Examiner refers back to and earlier portion of McConnell's disclosure, i.e., columns 10 and 13 which fail to discuss the digit string *72 identified by the Examiner as the claimed *identifier*. Accordingly, it was not clear why the Examiner refers to these portions of the disclosure.

In the final rejection the Examiner refers to Applicant's claim 7 *wherein the identifier*

indicating a request for the private mobile communication service is a character # or a character * as the reason for referring to McConnell's string, *72, but has still failed to show that McConnell discloses the whole of *establishing a traffic channel with the private base transceiver station when it is determined that the identifier is added to the dialed phone number, and establishing a traffic channel with the public base transceiver station when it is determined that the identifier is not added to the dialed phone number.*

The Examiner also referred to McConnell's col. 29, lines 42-43 and col. 27, lines 1-11 (quoted above). Col. 29, lines 40-45 state:

> "Given the configuration shown in FIG. 19, the neighbor lists for CDMA mobile stations would be similar to that described above for TDMA mobile stations.
>
> CDMA systems also take advantage of a CDMA mobile station's ability to communicate on more than one channel at a time to perform, to the extent possible, "soft" handoffs. During a "soft" handoff, a mobile station in communication with a first cell begins to communicate with a second cell. The communication with the first cell can be subsequently dropped when the signal level becomes too low. Soft handoffs are particularly desirable as they provide a "make before break" connection that is almost imperceptible to the user."

Accordingly, McConnell's col. 29, lines 42-43 also fail to discuss the digit string *72 identified by the Examiner as the claimed *identifier*. Accordingly, it is not clear why the Examiner referred to these portions of the disclosure.

McConnell's col. 27, lines 1-11 (quoted above) is the only section cited by the Examiner to discuss the digit string *72. There is no disclosure in any of the cited sections, including col. 27, lines 1-11, to suggest that when a mobile station is in a public/private common cell area, that *a traffic channel with the public base transceiver station* is established *when it is determined that the*

identifier (*72) *is not added to the dialed phone number.*

It is impermissible within the framework of §102 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly discloses.

The reference, as well as the Applicant's claims, must be considered as a whole.

A review of McConnell's disclosure, as a whole, finds that McConnell fails to disclose *said first mobile station determining whether an identifier indicating a request for the private mobile communication service is added to a dialed phone number entered by a user, establishing a traffic channel with the private base transceiver station when it is determined that the identifier is added to the dialed phone number,* ***and*** *establishing a traffic channel with the public base transceiver station when it is determined that the identifier is not added to the dialed phone number.* See Applicant's paragraphs [0055] and [0056].

Accordingly, McConnell fails to anticipate claim 1, thus the rejection of claim 1 is deemed to be in error and should be withdrawn.

Claim 12 is similar to claim 1 with regard to the claimed *identifier*, and is deemed to not be anticipated by McConnell for the same reasons as claim 1. Accordingly, claims 1, 3-7, 10-13, 15 and 16 are not anticipated by McConnell.

Claim 2

Claim 2 calls for, in part:

a private communication service apparatus verifying whether the first mobile station is a

subscriber to the private mobile communication service, when a request for establishing a radio communication channel is received by the private base transceiver station from the first mobile station.

Here the Examiner refers to McConnell's col. 10, lines 1-3; col. 13, lines 19-20; and col.29, lines 42-43, which respectively state:

> "The wireless communications provided by private wireless network 12 and public wireless network 14 may be in a format, such as AMPS, TDMA, GSM, CDMA, or some other format";
>
> "assistants, or other devices able to transmit or receive voice, data, or other media over an air interface. Private wireless"; and
>
> "similar to that described above for TDMA mobile stations.
>
> CDMA systems also take advantage of a CDMA mobile"

Clearly, there is no *verifying* process disclosed in the foregoing section of McConnell cited by the Examiner. Accordingly, it is not clear why the Examiner cited McConnell's col. 10, lines 1-3; col. 13, lines 19-20; and col.29, lines 42-43.

Here, in the final rejection, the Examiner disagrees, and refers to McConnell's col. 27, lines 32-66 stating, "McConnell disclose the verifying process one the networks received the user's identifier request between the public and private network HLR" (home location register).

Clearly, col. 27, lines 32-66 are not a portion of the previously cited sections, *i.e.*, McConnell's col. 10, lines 1-3; col. 13, lines 19-20; and col.29, lines 42-43 cited in the rejection, so it is not clear why the Examiner disagrees with the Applicant's argument that there is no *verifying* process disclosed in col. 10, lines 1-3; col. 13, lines 19-20; and col.29, lines 42-43.

Col. 27, lines 32-66 clearly do not disclose *a private communication service apparatus*

verifying whether the first mobile station is a subscriber to the private mobile communication service, when a request for establishing a radio communication channel is received by the private base transceiver station from the first mobile station.

Instead, Col. 27, lines 32-66 disclose a process illustrated in Figs. 17 and 18. FIG. 17 illustrates a simplified exemplary call flow that may be applied when mobile station 64 dials a feature code while operating in the coverage are of private network 12. The user of mobile station 64 dials the feature code, such as "*72" followed by a 10-digit number, and mobile station 64 responsively transmits a signal 900 containing the feature code. Private MSC 60 receives the feature code and sends an IS-41 Feature Request ("FEATREQ") message 902, identifying mobile station 64, to Gateway SCP 70.

FIG. 18 shows, in simplified form, an exemplary call flow for a mobile station 28 requesting a feature code update while it is in the coverage area of public network 14 being served by MSC 16. The user dials the feature code, and mobile station 28 responsively transmits a signal 920 containing the feature code. MSC 16 receives the feature code and transmits it to HLR 32 in a FEATREQ message 922. HLR 32 then updates the service profile for mobile station 28 contained in database 42 to reflect the requested update.

A review of all that McConnell discloses, finds disclosure at col. 9, lines 58-67, regarding a mobile station being a subscriber to the private mobile communication service 12, however, there is **no** disclosure of a *verifying* process.

Accordingly, McConnell fails to anticipate the feature of *a private communication service apparatus verifying whether the first mobile station is a subscriber to the private mobile communication service, when a request for establishing a radio communication channel is received*

by the private base transceiver station from the first mobile station, thus the §102 rejection of claim 2 is deemed to be in error and should be withdrawn.

Claim 11

Claim 1 has been amended to include the features of claim 11, wherein claim 11 requires that:

the first mobile station sends a signal indicating that the first mobile station is busy to the public base transceiver station when a traffic channel request signal is received through the public base transceiver station while the first mobile station is provided with the private mobile communication service through the private base transceiver station.

Here the Examiner refers us to McConnell's col. 10, lines 1-3, col. 13, lines 19-20 and col. 29, lines 23-45 on page 9 of the final Office action.

With respect to McConnell's col. 29, lines 23-45, the final Office action erroneously suggests that when a mobile station is in an overlapped coverage area between public and private wireless networks, the sending of a report or request for hand off corresponds to *a signal indicating that the first mobile station is busy* being sent *to the public base transceiver station.*

First, we note here that the claim, as a whole, is not being considered, but instead is being examined in a piece-wise manner. Here, the whole of claim 11 requires that the first mobile station sends a signal indicating that the first mobile station is busy to the public base transceiver station ***when a traffic channel request signal is received*** *through the public base transceiver station while the first mobile station is provided with the private mobile communication service through the private base transceiver station.* McConnell's col. 29, lines 23-45 make no mention of ***a traffic***

channel request signal is received. Nor is there mention of a traffic channel request signal being received *through the public base transceiver station while the first mobile station is provided with the private mobile communication service through the private base transceiver station.*

McConnell's col. 29, lines 23-45 merely discuss the continuous transmission of a measured signal strength, by a mobile station, being transmitted to a mobile switching center (MSC) through the base station transceiver (BTS), and the control of a 'handoff' if the measured signal strength of a neighboring cell is stronger than that of a current cell. This measurement of signal strength is not based upon a traffic channel request signal being received, and is especially not based on a traffic channel request signal being received *through the public base transceiver station while the first mobile station is provided with the private mobile communication service through the private base transceiver station.*

Second, it is well known in the art that a 'busy' signal is distinct from a 'signal strength' signal. That is, in the art of telephony, a 'busy' signal has definition different than that of a 'signal strength' signal. McConnell's specification does not discuss the use of a 'busy' signal.

Third, McConnell's col. 29, lines 23-45 disclose that 'handoff' is performed based on the signal strength signal being sent to the mobile switching center (MSC) it is already in contact with. If the mobile station is in a private cell area and in communication with private BTS 62, the signal strength signal is sent by private BTS 62 to private MSC 60 will initiate handoff. Thus, *while the first mobile station is provided with the private mobile communication service through the private base transceiver station, the first mobile station sends a signal indicating that the first mobile* station' s signal strength to the private base station transceiver, **not** *to the public base transceiver station.* See col 29, lines 20-24.

Claim 15 is similar to claim 11 and the features thereof are deemed to not be anticipated by McConnell for the same reasons as claim11. The features of claim 15 have been incorporated into claim 12.

Accordingly, claims 1 and 12 are deemed not to be anticipated by McConnell for the above reasons, thus the rejection should be withdrawn.

B. Claims 8 and 9 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over McConnell et al. in view of Miller, II et al. (US 5,406,615). The Applicant respectfully traverses this rejection for the following reason(s).

Miller fails to teach the features noted above as lacking in McConnell, thus claims 8 and 9 are not obvious under §103.

Claim 8

Claim 8 depends from claim 1 and is directed towards the first mobile station, wherein the first mobile station comprises:

- *a private network control unit;*
- *a private network Radio Frequency (RF) unit;*
- *a public network mobile phone unit;*
- *a main control unit;* and
- *a public network Radio Frequency (RF) unit.*

The Examiner refers us to Miller's Fig. 1, radiotelephone handsets 107, cordless telephone

base station (CS) 115, base station (BS) 104 and col. 1, lines 45-56, which state:

> "A universal wireless radiotelephone communication apparatus is operative in both a first radiotelephone communication system including a first base station having a wide geographical area of coverage, transmitting radiotelephone signals at a first band of frequencies and in a second radiotelephone communication system including a second base station having a localized short distance area of coverage, transmitting radiotelephone signals at a second band of frequencies higher than said first band of frequencies. The second band of frequencies can be optimally selected with an appropriate offset of less than twice a frequency contained within said first band."

It is clear that the Examiner is relying on the "gist" of Miller's invention to reject the claimed invention, which is contrary to case law. *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Note, *Ex parte Levy*, 17 USPQ2d 1461, 1462 (1990) states:

> "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

The Examiner's remarks concerning the foregoing are not understood, as they fail to identify where Miller teaches using these separate frequencies based upon a determination that an identifier is added to the dialed phone number or not.

It is insufficient to suggest modifying McConnell, just because Miller is known to use two frequency bands. That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Accordingly, the rejection of claim 8 is deemed to be in error and should be withdrawn.

Claim 9

Applicant discloses in paragraph [0071]: The antenna matching unit 310 receives RF signals in different frequency bands of private and public mobile communication services-only channels, respectively, through the antenna ANT, separates the RF signals, and matches the separated RF signals with corresponding RF units. Further, even in the case of transmission, the antenna matching unit 310 transmits RF signals from corresponding RF units through the antenna ANT.

Claim 9 depends from claim 8 and is directed towards the first mobile station, wherein the first mobile station comprises:

an antenna matching unit that receives RF signals in different frequency bands of private and public mobile communication services-only channels, respectively, through an antenna, separates the RF signals, and matches the separated RF signals with the corresponding private or public network Radio Frequency (RF) units, and transmits RF signals from the private or public network Radio Frequency (RF) units through the antenna.

The Examiner states: "common baseband circuitry" corresponds to "antenna matching unit", referring to Miller's col.2 lines 19-31, which state:

> An illustrative wireless radiotelephone communication mobile subscriber apparatus (e.g. a handset) has a common baseband circuitry having a functionality, which is extendible across the first and second radiotelephone communication systems, for operating with both the first base station covering the wide area and with the second base station covering the local area. The common baseband circuitry processes received radiotelephone signals, within the first and second bands of frequencies, from both base stations and processes signals generated by a user of the radiotelephone handset for transmission within the first and third band of frequencies to either of these base stations.

Antenna matching units do not include nor correspond to "common baseband circuitry".

Additionally, the Examiner has failed to provide a *prima facie* showing where the "common baseband circuitry" teaches the features of the claimed antenna matching unit which *receives RF signals in different frequency bands of private and public mobile communication services-only channels, respectively, through an antenna, separates the RF signals, and matches the separated RF signals with the corresponding private or public network Radio Frequency (RF) units, and transmits RF signals from the private or public network Radio Frequency (RF) units through the antenna.*

The final rejection fails to identify where the features of the claimed antenna matching unit, which *receives RF signals in different frequency bands of private and public mobile communication services-only channels, respectively, through an antenna, separates the RF signals, and matches the separated RF signals with the corresponding private or public network Radio Frequency (RF) units, and transmits RF signals from the private or public network Radio Frequency (RF) units through the antenna*, are found in Miller.

Accordingly, the rejection of claim 9 is deemed to be in error and should be withdrawn.

Note that the Examiner has not identified which elements of Miller's Fig. 3 correspond to the elements listed above with respect to claim 8, and has not identified which elements of Miller's Fig. 3 correspond to the claimed antenna matching unit.

Instead, the Examiner appears to erroneously apply the gist of Miller's invention in rejecting claims 8 and 9.

> *In re Rijckaert*, 28 USPQ2d 1955 (CAFC 1993) states:
>
> "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell,* 991

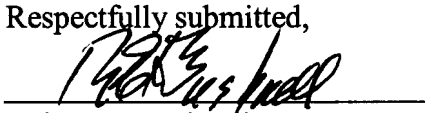
F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rhinehart,* 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Accordingly, the rejection of claims 8 and 9 is deemed to be in error and should be withdrawn.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Fees for filing a Request for Continued Examination (RCE) and for a Petition for a two-month extension of time accompany this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicants' undersigned attorney in the amount of such fees.

Respectfully submitted,



Robert E. Bushnell
Attorney for Applicants
Reg. No.: 27,774

1522 K Street, N.W.
Washington, D.C. 20005
(202) 408-9040

Folio: P56970
Date: 8/9/07
I.D.: REB/MDP